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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/30/2003

Loc Nguyen

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EXAMINER

RETTA, YIHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,723

Applicant(s)

NGUYEN ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 6/21/06 11/17/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 , 7 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites "processing with the transaction based on a first set of rules" and "processing the transaction based on a second set of rules". Claim 1 only recited a method comprising use of a portable device to conduct the transaction, however the claim does not positively recite conducting transaction using the device. It simply recites intended use of the portable device. Therefore, claim 6 is rejected for being indefinite.

Claim 7 recited "determining if redemption for the transaction is possible". First it is unclear what applicant considers "redemption for transaction" is. Second it is unclear what the terms and condition has to do with the redemption and also with the rules. There is no relationship or connection between the acceptance of the terms and condition and the redemption and set of rules.

Claim 34 is also rejected as stated above since it recited similar limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Toole, JR. et al. (US 2001/0037467).

Regarding claims 1-5 and 8, O'Toole teaches using a portable device to conduct the transaction, the portable device having portable device information; determining if a terms and conditions statement is needed for the transaction based on the portable device information; dynamically generating the terms and conditions statement for the transaction; and outputting the generated terms and conditions statement; using the portable device information to dynamically generate the terms and conditions statement; wherein the information related to the portable device comprises information indicating whether the terms and conditions statement has been accepted before; and wherein the terms and conditions statement is not generated if the terms and conditions statement has been accepted before; determining information related to a device outputting the generated terms and conditions statement; wherein the information related to the device comprises information indicating whether the device is capable of displaying or printing the terms and conditions statement, wherein the terms and conditions statement is dynamically generated for a display format or a printed format based on the information related to the device; and wherein outputting the terms and conditions statement comprises displaying the terms and conditions statement in the displayed format or printed format (see [0045]-[0049]).

Regarding claims 6 and 7, O'Toole teaches receiving input indicating whether the terms and conditions statement is accepted; if the terms and conditions statement has been accepted,

processing with the transaction based on a first set of rules; and if the terms and conditions statement has not been accepted, processing the transaction based on a second set of rules (see [0045]).

Regarding claim 24-27, O'Toole teaches a plurality of T&C files and a plurality of parameter files useable to generate T&C statements; control logic configured to select a T&C file from the plurality of T&C files and a parameter file from the plurality of parameter files for a loyalty transaction; and control logic configured to dynamically generate a T&C statement for the transaction using the selected T&C file and the selected parameter file; wherein the control logic selects the T&C file and the parameter file using information specific to the loyalty transaction; wherein the information specific to the loyalty transaction comprises at least one of portable device information for a portable device, information related to how the device can output the T&C statement, information that indicates if the T&C statement has been accepted before, and information that indicates if redemption is possible for the loyalty transaction; further comprising control logic configured to communicate with the portable device to save information on the portable device regarding whether the T&C statement has been accepted by a user of the portable device (see [0045]-[0049]).

Regarding claim 1, only when a T&C is needed the T&C is generated and outputted. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Claims 9, 10, 12-23, 35-38, 39-45, 46-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Iannacci (US 2002/0062249).

Regarding claims 9, 10, 12 and 13, Iannacci teaches obtaining parameters for a loyalty program; determining T&C information for the loyalty program from the parameters; sending the T&C information to a distribution channel, wherein the T&C information enables the distribution channel to dynamically generate T&C statements for one or more portable devices for corresponding loyalty transactions; wherein the T&C information comprises a plurality of tags; (see fig. 4 & 6 and [0008]), fig 14, 16).

Regarding claims 14-23, Iannacci teaches an information determiner configured to determine information specific to a loyalty transaction; logic to dynamically generate a T&C statement based on the determined information for the loyalty transaction; and an output to output the generated T&C statement; wherein the information specific to the loyalty transaction comprises a T&C file that includes information useable to generate the T&C statement; wherein the information specific to the loyalty transaction comprises a parameter file that includes information useable to generate the T&C statement; wherein the T&C file includes tags that correspond to parameters in the parameter file, the corresponding parameters being used to generate the T&C statement; wherein the information specific to the loyalty transaction includes information retrieved from a portable device; wherein the information retrieved from the portable device includes user information and information relating to a loyalty program; wherein the T&C statement is generated based on characteristics of the device (see fig. 4, 6, 8, 10, 12B, and associated paragraphs).

Regarding claims 35-38, 39-45, 46-62, Iannacci teaches one or more portable devices; a plurality of distribution channels, each distribution channel comprising: an information determiner configured to interact with a portable device to determine information specific to a loyalty transaction; logic to generate a T&C statement for the loyalty transaction based on the determined information; and an output to output the generated T&C statement; wherein the information specific to the loyalty transaction comprises portable device information specific to the portable device; wherein the information specific to the loyalty transaction comprises at least one of information related to the output, information indicating if the T&C statement has been accepted before, and information indicating if redemption is possible for the loyalty transaction; further comprising a host, the host configured to communicate with the plurality of distribution channels and transmit information used to determine how to generate the T&C statement(see fig. 4, 6, 8, 10, 12B, and associated paragraphs).

Examiner would like to point out that the claim recites that only if it the T&C are accepted that the transaction is processed. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Regarding claim 46, only when it is determined that a T&C is to be generated for a transaction that the T&C is generated. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Claims 28-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Bam et al. (US 2004/0083170).

Regarding claims 28-34, Bam teaches determining if a T&C statement is needed for a loyalty transaction; if the T&C statement is needed, determining information specific to the loyalty transaction; generating the T&C statement dynamically using the information specific to the loyalty transaction; and outputting the generated T&C statement; wherein determining information specific to the loyalty transaction comprises: determining portable device information specific to a portable device; and wherein generating the T&C statement comprises using the portable device information to dynamically generate the T&C statement; wherein the information related to the portable device comprises at least one of information indicating whether the T&C statement has been accepted before, wherein the T&C statement is not generated and outputted if the T&C statement has been accepted before; determining information related to a device outputting the generated T&C statement; and wherein generating the T&C statement further comprises dynamically generating the T&C statement using the information related to the device; wherein the information related to the device comprises information indicating whether the device is capable of displaying or printing the T&C statement; wherein the T&C statement is generated for a display format or a printed format based on the information related to the device; and wherein outputting the generated T&C statement comprises displaying the T&C statement in the display format or printed format; receiving input indicating whether the T&C statement is accepted; if the T&C statement has been accepted, processing the loyalty

transaction according to a first set of rules; and if the T&C statement has not been accepted, processing the loyalty transaction according to a second set of rules (see fig. 4-6, [0055]-[0059]).

Examiner would like to point out that the claim recites that only if it is determined that a T&C is needed that the rest of the steps are performed. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iannacci as applied to claim 9 above, and further in view of Thurlow et al. (US 5,917,489).

Regarding claim 11, Iannacci does not teach wherein the plurality of tags comprises a template that is used to dynamically generate a T&C statement for at least one of the one or more portable devices. Thurlow teaches creating of rules using templates and tags. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a template to create the rules and condition of Iannacci in order to simplify the creation of the document, as taught in Thurlow (see col. 17 lines 35-53).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622